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10/686,998

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Patrick J. Sweeney

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EXAMINER

MILLER, CHERYL L

ART UNIT

PAPER NUMBER

3738

NOTIFICATION DATE

DELIVERY MODE

07/09/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/686,998 | <b>Applicant(s)</b><br>SWEENEY, PATRICK J. |  |
|                              | <b>Examiner</b><br>CHERYL MILLER     | <b>Art Unit</b><br>3738                    |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) 10,12,18,22,28,37,43,66 and 70 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-9,11,13,15,17,21,23,25,27,29,30,32,34,36,38,39,41,61,63,64,68,69 is/are rejected.
- 7) ☒ Claim(s) 65 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Continuation of Disposition of Claims: Claims pending in the application are 1,3,5-13,15,17,18,21-23,25,27-30,32,34,36-39,41,43,61,63-66 and 68-70.

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments with respect to the previous rejections have been considered but are moot in view of the new ground(s) of rejection. Because previously indicated allowable claims are herein rejected, the current office action is NON-FINAL.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3, 5, 7-9, 11, 13, 17, 21, 23, 27, 29, 30, 32, 36, 38, 39, 61, 63, 64, 68, and 69 are rejected under 35 U.S.C. 102(e) as being anticipated by Buttermann (US 2005/0113924 A1). Buttermann discloses a spinal implant system (figs.15, 17, 21, 24) comprising a vertebral prosthesis (fixation member; 214 for example) comprising a support (224) with a first portion slidably received in a second portion (see figs) and prosthesis endplate (252), an artificial disc comprising a disc endplate (244) and disc core (242+240), the artificial disc interlocked with the prosthesis endplate (by recess and flange, morse taper connection), an a pedicle screw retainer (holes in fixation member; P0095; P0106) having top, bottom and aperture (246, 510) for a screw (310) capable of penetrating a pedicle. Buttermann discloses a locking ring (C-clamp; P0117).

Claims 1, 3, 5-7, 32, 34, 38, 61, 63, and 68 are rejected under 35 U.S.C. 102(b) as being anticipated by Hedman et al. (US 4,759,769, cited previously). Hedman discloses a system (fig.1, 2) comprising a vertebral prosthesis having a support shaft (right 72+74) having a first portion (74) slidably receiving in a second portion (72), and a prosthesis endplate (26) and a spinal disc comprising a disc endplate (28) and disc core (left 72+74), an interlock structure (recess 34 or 52) and a pedicle screw retainer (46) coupled to the support (26) the retainer having a top, bottom, sidewall and aperture configured to receive a pedicle screw (94, 96, screws adapted for placement into the pedicles). Hedman discloses an adjustable height support shaft (shaft 74+72 is a spring and compresses to different heights, the two springs having different spring constants thus slide past one another during height adjustment). It is noted with respect to claim 32, first and second discs are not positively claimed since the phrase implanted adjacent either a first or second disc is intended use language and the claim does not define the discs to be part of the spinal implant system, only capable of use with disc implants, thus disc implants need not be present in the prior art. Hedman's core (72) does not rotate relative the endplate (26).

Claims 1, 5, 7, 11, 13, 32, 38, 61, 63, 68, and 69 are rejected under 35 U.S.C. 102(e) as being anticipated by Malek (US 2005/0071007 A1, cited previously). See figures 25-28. Malek discloses a support shaft (240+232) having a first portion (232) slidably received (alternate to threaded connection is disclosed a saw tooth connection thus slidable, P0049, P0071), in a second portion (240), first prosthesis endplates (286), an artificial disc having a core (302) and disc endplate (270), the disc (270+302) coupled to the prosthesis endplate (286) by an interlocking structure (complimentary surfaces, concave/convex). Malek discloses a pedicle

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screw retainer (tab 268 or portion of baseplates, see P0054) for receiving a screw (270; fig.28) *capable* of extending through a pedicle.

Claim 39 is rejected under 35 U.S.C. 102(b) as being anticipated by Buttermann (US 5,827,328, cited previously). Buttermann discloses a prosthesis system comprising a shaft having a first and second slidable portions (65, 67) to adjust the height, a first endplate (35 or 32) coupled to a first disc (18), a second endplate (31 or 32) coupled to a second disc (different 18), the discs having different configuration (different sized springs or spring constants are disclosed; figs.3a-3c; col.5, lines 45-55), and a pedicle screw retainer (screws attached to prosthesis; col.7, lines 16-20), the discs having a core (40) and endplate (42).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 15, 25, 34, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buttermann (US 2005/0113924 A1). Buttermann discloses the spinal prosthesis substantially as claimed (see above). Buttermann discloses the prosthesis endplate and support to be attached, however is silent to mention how they are connected. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have one of the claimed connections (threaded, snapped, or twisted), since such are common attachment means.

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It would be common sense to use any form of attachment, as Buttermann is silent to a specific attachment method.

Claims 1, 3, 6, 7, 9, 11, 13, 15, 32, 34, 38, 41, 61, 63, 68, and 69 rejected under 35 U.S.C. 103(a) as being unpatentable over Buttermann (US 5,827,328 (cited previously) in view of Hedman (US 4,759,769, cited previously). Buttermann discloses a spinal implant system (figs.7) comprising a vertebral prosthesis (fixation member; 14 for example) comprising a support (24) with a first portion slidably received in a second portion (67, 65) and prosthesis endplate (31 or 32), an artificial disc comprising a disc endplate (42 or 44) and disc core (40 or 40+42), the artificial disc interlocked with the prosthesis endplate (by adhesive). Buttermann discloses the implant system substantially as claimed however does not disclose a pedicle screw retainer on the vertebral prosthesis. Buttermann does disclose the option of supplemental anchors such as screws, but is silent as to where they are attached and how. Hedman teaches in the same field of spinal implant systems, the use of a tab (46) with aperture on an endplate for attachment of a screw for better securement (col.3, lines 50-69). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine Buttermann's vertebral prosthesis with disclosure of possible anchoring means with Hedman's particular anchoring means (tabs with apertures considered pedicle screw retainers with top, bottom and aperture) in order to provide a prosthesis with increased anchoring capabilities.

Referring to claims 6, 15, 34, and 41, Buttermann discloses the prosthesis endplate and support to be attached, however is silent to mention how they are connected. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have one of

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the claimed connections (threaded, snapped, or twisted), since such are common attachment means. It would be common sense to use any form of attachment, especially common means such as threaded and snapped, as Buttermann is silent to a specific attachment method.

### ***Allowable Subject Matter***

Claim 65 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHERYL MILLER whose telephone number is (571)272-4755. The examiner can normally be reached on Monday-Friday 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4755. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Cheryl Miller/  
Examiner, Art Unit 3738

/Corrine M McDermott/  
Supervisory Patent Examiner, Art Unit 3738